

In the Claims:

Please cancel claims 2, 5, and 9-11 without prejudice.

REMARKS

The Office Action objected to the specification as failing to correctly identify the status of application number 09/041,352. The status of this application has been updated by amendment.

The Office Action treats claims 2, 5, and 9-11, differently than the other pending claims. It appears to applicants that resolution of the issues concerning these claims is likely to delay the issuance of a patent directed to the subject matter of these other pending claims. Accordingly, for the sole purpose of expediting the prosecution, applicants have canceled claims 2, 5, and 9-11 without prejudice. Accordingly, claims 1, 4, and 7-16 are pending. Additionally, no new matter has been added by way of this Amendment.

Now turning to the remaining claims. Applicants respectfully request a full reconsideration of the application, because it appears possible to applicants that the Office will not consider the present basis of rejection well founded now that there are no claims that require the "separation of any type of biological material from any type of ligand in any type of environment." In the event that the Office does not agree with the foregoing, please consider the following observations:

All pending claims stand rejected under Section 112, first paragraph. No other basis of rejection is recited in the Office Action.

The Office Action states that no working examples are given. Applicants have two responses. First, working examples are not required by law. The Office Action itself acknowledges this point. Second, the specification, as has already been pointed out in this record, discloses an exemplary circuit which can be usefully employed in the practice of the present invention without any undue experimentation. In that regard, any required experimentation would be trivial, and there is no evidence of record to the contrary.

The Office Action cites to page 57, lines 4-10, of the specification, and suggests that this passage amounts to a mere invitation for others to experiment so as to make the claimed invention. Applicants strenuously disagree. Any uncertainty in this passage merely refers to possible mechanisms of action by which the claimed invention operates. Of course, applicants are under no obligation to identify, know, or disclose the mechanism by which their invention works. Accordingly, applicants respectfully submit that this passage is not a proper basis for an enablement rejection.

Separately, the Office Action cites to case law for the proposition that the specification must set forth at least some conditions to be used in practicing the claimed

invention to avoid unfairly shifting the burden of enablement from the applicant to the public. In particular, at page 53, line 23, to page 56, line 2, the specification discloses a circuit suitable for practicing the claimed invention. The Office Action alleges, *without support*, that the skilled artisan equipped with the disclosed circuit, let alone with one similar to it, or a suitably equivalent, would not be able to "apply a voltage ... to reduce the ability of the first nucleic acid ... to be amplified or detected in PCR." In this regard, the Office Action does not identify where the alleged undue burden of experimentation would arise. Rather, the Office Action rejects the claims as unenabled on the basis that applicants' disclosure allegedly is not sufficiently detailed.

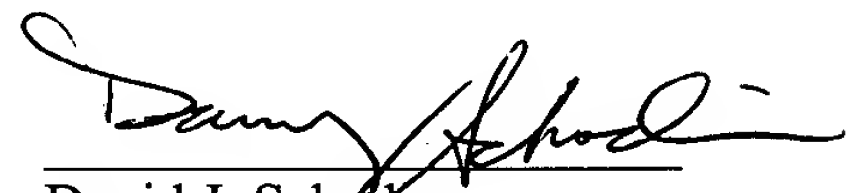
Applicants respectfully submit that Patent Office regulations require that the Examiner accept as credible applicants claims of utility unless a reasoned basis to doubt the asserted credibility exist. Applicants further submit that the recitation of speculation as to the mechanism of action of the claimed invention does not provide a reason to doubt the enablement of the claimed invention. Applicants respectfully request that the Examiner explicitly identify any information relied upon by the Examiner in support of the enablement rejection, but which has not previously been explicitly identified to applicants.

In view of the foregoing remarks, applicants submit that the application is in condition for allowance, and request favorable action.

Dated: December 20, 2001

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Respectfully submitted,
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant: G. Gundling, *et al.*

Examiner: B. Sisson

Serial No.: 09/492,213

Group Art Unit: 1655

Filed: January 27, 2000

Title: METHOD OF PROCESSING A
SAMPLE CONTAINING AT
LEAST ONE BIOLOGICAL
ELEMENT

Case No.: 6416.US.P1

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Commissioner for Patents
Washington, D.C. 20231


ATTACHMENT TO AMENDMENT

(Amendment) A number of structures may be joined together or integrated to meet individual needs, such as modifying the number of tests performed in a given time period (throughput), tailoring the items of interest to be determined, etc. For example a number X of structures which perform Y determinations in a given hour may be connected such that the connected structures perform XY determinations in an hour. If desired, the resources of the structures may be allocated in a manner substantially similar to that disclosed in [co-pending] U.S. Patent [application, Serial] No. [09/041,352] 6,022,746 filed on March 12, 1998. That application is assigned to the assignee of the present case and the disclosure thereof is incorporated herein in its entirety.

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